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OFFICE OF PETITIONS

In re Application of
Li, et al.
Application No. 10/829,590
Filing Date: 21 April, 2004
Attorney Docket No.: 034172-017

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DECISION

This is a decision on the petition filed on 4 May, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, and alternatively seeking revival of the application under 37 C.F.R. §1.137.

For the reasons set forth below, the petition considered under 37 C.F.R. §1.181 is **DISMISSED**; the petition under 37 C.F.R. §1.137(a) is **DISMISSED**; and the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTE:

Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected.

Moreover, Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

NOTES:

The Revocation/Power of Attorney submitted is acknowledged and entered.

Petitioner apparently was not Counsel of record at the time the application went abandoned and thus cannot make the statement of unintentional delay. To this end, the regulatory statement of unintentional delay by the Applicant, former Counsel or Assignee (with the required certificate under 37 C.F.R. §3.73(b)) will be necessary.

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled “Renewed Petition under 37 C.F.R. §1.181.”

(If Petitioner is unable to present even a satisfactory showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner’s only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

- (2) Thereafter, there will be no further reconsideration of this matter.¹

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non final Office action mailed on 6 July, 2005, with reply due under a non-extendable deadline on or 6 October, 2005;
- the instant application went abandoned after midnight 6 October, 2005;
- the Office mailed a Notice of Abandonment on 13 February, 2005;
- on 4 May, 2006, Petitioner filed the instant petition, further supplemented, requesting that

¹ For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

the Office “set aside the holding of abandonment”² and “requests that the application be revived”³—which are alternative requests for relief—the former under 37 C.F.R. §1.181 and the latter under 37 C.F.R. §1.137(a) or (b)—and making the argument that Petitioner provided to the Office ON 9 November, 2004, Notice of the change of address (under 37 C.F.R. §1.33 and consistent with MPEP §403⁴ and

² At the first page of the petition.

³ At the third page of the petition.

⁴ The commentary at MPEP §403 provides, in pertinent part:

403 Correspondence — With Whom Held [R-3]

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

* * *

37 CFR 1.33(a) provides for an applicant to supply an address to receive correspondence from the U.S. Patent and Trademark Office so that the Office may direct mail to any address of applicant's selection, such as a corporate patent department, a firm of attorneys or agents, or an individual attorney, agent, or other person.

37 CFR 1.33(a) provides that in a patent application the applicant must specify a correspondence address to which the Office will send notices, letters and other communications relating to the application. The correspondence address must appear either in an application data sheet (37 CFR 1.76) or in a clearly *->identifiable< manner elsewhere in any papers submitted with an application filing. Where more than one correspondence address is specified, the Office will determine which one to establish as the correspondence address. This is intended to cover>, for example,< the situation where an application is submitted with multiple addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying 37 CFR 1.63 oath or declaration, or other similar situations. The determination of which of the correspondence addresses to use will be made on a case-by-case basis, considering such factors as the earliest correspondence address submitted, and the first listed correspondence address if conflicting addresses appear in the same declaration. >If more than one correspondence address is specified in a single document, the Office will use the address associated with a Customer Number over a typed correspondence address.<

37 CFR 1.33(a) requests the submission of a daytime telephone number of the party to whom correspondence is to be addressed. While business is to be conducted on the written record (37 CFR 1.2), a daytime telephone number would be useful in initiating contact that could later be reduced to writing. The telephone number would be changeable by any party who could change the correspondence address.

37 CFR 1.33(a)(1) provides that any party filing the application and setting forth a correspondence address could later change the correspondence address provided that a 37 CFR 1.63 oath/declaration by any of the inventors has not been submitted. If one joint inventor filed an application, the person who may change the correspondence address would include only the one inventor who filed the application, even if another inventor was identified on the application transmittal letter. If two of three inventors filed the application, the two inventors filing the application would be needed to change the correspondence address. Additionally, any registered practitioner named in the application transmittal letter, or a person who has the authority to act on behalf of the party that will be the assignee (if the application was filed by the party that will be the assignee), could change the correspondence address. A registered practitioner named in a letterhead would not be sufficient, but rather a clear identification of the individual as being a representative would be required. A company (to whom the invention has been assigned, or to whom there is an obligation to assign the invention) who files an application, is permitted to designate the correspondence address, and to change the correspondence address, until such time as a (first) 37 CFR 1.63 oath/declaration is filed. The mere filing of a 37 CFR 1.63 oath/ declaration that does not include a correspondence address does not affect any correspondence address previously established on the filing of the application, or changed per 37 CFR 1.63(a)(1), even if the application was filed by a company that is only a partial assignee. The expression “party that will be the assignee,” rather than assignee, is used in that until a declaration is submitted, inventors have only been identified, and any attempted assignment, or partial assignment, cannot operate for Office purposes until the declaration is supplied. Hence, if the application transmittal letter indicates that the application is being filed on behalf of XYZ company, with an assignment to be filed later, XYZ company would be allowed to change the correspondence address without resort to 37 CFR 3.73(b) until an executed oath or declaration is filed, and with resort to 37 CFR 3.73(b) after the oath or declaration is filed.

Where a correspondence address was set forth or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of a 37 CFR 1.63 oath or declaration), that correspondence address remains in effect upon filing of a 37 CFR 1.63 declaration and can then only be changed pursuant to 37 CFR 1.33(a)(2).

37 CFR 1.33 states that when an attorney >or agent< has been duly appointed to prosecute an application>,< correspondence will be held with the attorney >or agent< unless some other correspondence address has been given. >If an attorney or agent of record assigns a correspondence

address which is different than an address where the attorney or agent normally receives mail, the attorney or agent is reminded that 37 CFR 10.57 requires the attorney or agent to keep information obtained by attorney/agent – client relationship in confidence. Double correspondence with an applicant and his or her attorney, or with two representatives, will not be undertaken. See MPEP § 403.01, § 403.02, and § 714.01(d). If double correspondence is attempted, form paragraph 4.01 should be included in the next Office action.

I. < CUSTOMER NUMBER PRACTICE

A Customer Number (previously a "Payor Number") may be used to:

- (A) designate the correspondence address of a patent application **>or patent< such that the correspondence address for the patent application >or patent< would be the address associated with the Customer Number >(37 CFR 1.32(a)(4)(i))<;
- (B) designate the fee address (37 CFR 1.363) of a patent ** such that the fee address for the patent would be the address associated with the Customer Number >(37 CFR 1.32(a)(4)(ii))<; and
- (C) submit a list of practitioners ** such that ** those practitioners associated with the Customer Number >would have power of attorney (37 CFR 1.32(a)(4)(iii))<.

Thus, a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application (or patent) or the fee address of a patent, and may also be used to submit a power of attorney in the application (or patent) to the registered practitioners associated with the Customer Number.

Applicant may use either the same or different customer number(s) for the correspondence address, the fee address and/or a list of practitioners. The customer number associated with the correspondence address is the Customer Number used to obtain access to the Patent Application Information Retrieval (PAIR) system at <http://pair.uspto.gov>. See MPEP § 1730 for additional information regarding PAIR.

The Office will also accept requests submitted electronically via a computer-readable diskette to **change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number**>.<

Such electronic requests must be submitted in the manner set forth in the Notice entitled "Extension of the Payor Number Practice (through "Customer Numbers") to Matters Involving Pending Patent Applications," published in the *Federal Register* at 61 FR 54622, 54623-24 (October 21, 1996), and in the *Official Gazette* at 1191 O. G. 187, 188-89 (October 29, 1996). >Note that such electronic requests are no longer accepted to change the power of attorney in a patent application or patent. See the notice entitled "Notice of Elimination of Batch Update Practice to Change Power of Attorney," published in the *Official Gazette* at 1272 O.G. 24 (July 1, 2003).<

**>With Customer Number practice, a< patentee **>is also< able to designate a "fee address" for the receipt of maintenance fee correspondence, and a different address for the receipt of all other correspondence. The designation of a "fee address" by reference to a Customer Number will not affect or be affected by the designation of a correspondence address by reference to another Customer Number, in that the Office will send maintenance fee correspondence to the address associated with the Customer Number designated as the "fee address" and will send all other correspondence to the address associated with the Customer Number designated as the correspondence address.

The association of a list of practitioners with a Customer Number will permit an applicant to appoint all of the practitioners associated with the Customer Number merely by reference to the Customer Number in the Power of Attorney (i.e., without individually listing the practitioners in the Power of Attorney). The addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number >by submitting a corresponding "Request for Customer Number Data Change" (PTO/SB/124)< will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant >or assignee of the entire interest of the applicant< who appointed all of the practitioners associated with such Customer Number. This will avoid the necessity for the filing of additional papers in each patent application affected by a change in the practitioners of the law firm prosecuting the application. The appointment of practitioners associated with a Customer Number *>is< optional, in that any applicant may continue to individually name those practitioners to represent the applicant in a patent application>, so long as fewer than ten patent practitioners are named. See 37 CFR 1.32(c)(3)<.

The Customer Number practice does not affect the prohibition against, and does not amount to, an appointment of a law firm (rather than specified practitioners). The Office prohibits an appointment of a specified law firm because the Office cannot ascertain from its records whether a particular practitioner submitting a paper to the Office is associated with the law firm specified in an appointment. The Office will permit an appointment of all of the practitioners associated with a specified Customer Number because the Office can ascertain from its records for the specified Customer Number whether a particular practitioner is associated with that Customer Number.

As the Office will not recognize more than one correspondence address (37 CFR 1.33(a)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application would be resolved in favor of the address of the Customer Number. Due to the prohibition against dual correspondence in an application (37 CFR 1.33(a)), an applicant will be permitted to provide only a single number at a time as the Customer Number for the correspondence address.

Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners, such action would be treated as only an appointment of all of the practitioners associated with a Customer Number due to the potential for confusion and data entry errors in entering registration numbers from plural sources. >Furthermore, Office computer systems do not allow for entry of both a power of attorney to a list of practitioners associated with a Customer Number and a list of practitioners.< Although Customer Numbers are designed to designate both a correspondence address and to associate one or more patent attorneys or agents with an application, one Customer Number may be used for the correspondence address, and another Customer Number may be used for the power of attorney.

Applicants are strongly cautioned not to attempt to appoint more than one Customer Number for a particular purpose (e.g., correspondence

§603⁵) by virtue of the separate paper filed, to wit: the executed oath or declaration, and

address) in a single communication, as such action will **not** have a cumulative effect.

The Office has created a *Mail Stop< designation for correspondence related to a Customer Number ("**Mail Stop EBC<"), and all correspondence related to a Customer Number (e.g., requests for a Customer Number) should be addressed to this *Mail Stop< designation. The following persons are authorized to change the information associated with an established Customer Number: (1) a registered practitioner associated with the Customer Number; and (2) the person who requested the Customer Number (signed the Request for Customer Number, Form PTO/SB/125).

* * *

⁵ The commentary at MPEP§603 provides in pertinent part:

601.03 Change of Correspondence Address [R-3]

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

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(a) Correspondence address and daytime telephone number.

When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a registered patent attorney or patent agent, or with more than one registered patent attorney or patent agent except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will establish one as the correspondence address and will use the address associated with a Customer Number, if given, over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:<

(1) *Prior to filing of § 1.63 oath or declaration by any of the inventors.* If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a registered attorney or agent, any other registered practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.* If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

37 CFR 1.33(a) provides that the application must specify a correspondence address to which the Office will send notice, letters, and other communications relating to an application. The correspondence address must either be in an application data sheet (37 CFR 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with the application filing. **>If more than one correspondence address is specified in a single document, the Office will establish one as the correspondence address and will use the address associated with a Customer Number, if given, over a typed correspondence address. Additionally, applicants will often specify the correspondence address in more than one paper that is filed with an application, and the address given in the different places sometimes conflicts. Where the applicant specifically directs the Office to use non-matching correspondence addresses in more than one paper, priority will be accorded to the correspondence address specified in the following order: (A) Application data sheet (ADS); (B) application transmittal; (C) oath or declaration (unless power of attorney is more current); and (D) power of attorney. Accordingly, if the ADS includes a typed correspondence address, and the declaration gives a different address (i.e., the address associated with a Customer Number) as the correspondence address, the Office will use the typed correspondence address as included on the ADS. In the experience of the Office, the ADS is the most recently created document and tends to have the most current address. After the correspondence address has been entered according to the above procedure, it will only be changed pursuant to 37 CFR 1.33(a)(1).<

The submission of a daytime telephone number of the party to whom correspondence is to be addressed is requested pursuant to 37 CFR 1.33(a). While business is to be conducted on the written record (37 CFR 1.2), a daytime telephone number would be useful in initiating contact that could later be reduced to * writing. Any party who could change the correspondence address could also change the telephone number. 37 CFR 1.33(a)(1) provides that the party filing the application and setting forth a correspondence address may later change the correspondence address provided that an executed oath or declaration under 37 CFR 1.63 by any of the inventors has not been filed. If a registered attorney or agent filed the application, any other registered practitioners named in the transmittal letter may change the correspondence address. A registered practitioner named in a letterhead would not be considered as being named in the transmittal letter for purposes of changing the correspondence address. A clear identification of the individual as a representative would be required. If an application is filed by a company to whom the invention has been assigned or to whom there is an obligation to assign the invention, a person who has the authority to act on behalf of the company may change the correspondence address. Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address

to this end Petitioner provides, *inter alia*, what are averred to be true copies of the date-stamped ("NOV 09 2004 OIPE") receipt card (see: MPEP §503⁶) and oath/declaration.

pursuant to 37 CFR 1.33(a)(1). The filing of an executed oath or declaration that does not include a correspondence address does not affect any correspondence address previously established on filing of the application, or changed pursuant to 37 CFR 1.33(a)(1).

Where a correspondence address has been established on filing of the application or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of an executed oath or declaration under 37 CFR 1.63 by any of the inventors), that correspondence address remains in effect upon filing of an executed oath or declaration under 37 CFR 1.63 and can only be subsequently changed pursuant to 37 CFR 1.33(a)(2). Under 37 CFR 1.33(a)(2), where an executed oath or declaration under 37 CFR 1.63 has been filed by any of the inventors, the correspondence address may be changed by (A) a registered attorney or agent of record, (B) an assignee as provided for under 37 CFR 3.73(b), or (C) all of the applicants (37 CFR 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71. See 37 CFR 1.33(a)(2).

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office. See MPEP § 403 for Customer Number Practice. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or may be retained by applicant. See MPEP § 502.02.

Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. 37 CFR 1.63(d)(4).

See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old correspondence address.

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

The obligation (see 37 CFR *11.11<) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

⁶ MPEP §503 provides in pertinent part:
§503 Application Number and Filing Receipt

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The argument, while interesting, is factually incorrect—the record reflects that the executed oath/declaration was filed on deposit on deposit of the application on 21 April, 2004.

On brief review of the record, Petitioner may have thought that the oath filed in November of 2004 was the first executed oath/declaration in response to a requirement in the 9 July, 2004, Notice of Missing Parts, however, that paper alerted Petitioner to fees and formalities requirements.

Thus, thereafter Petitioner was required to Notice the Office as to the change—not simply submit the papers. The information as to the address change was in a customer number inside the oath/declaration filed on 9 November, 2004, and Petitioner provided no Notice to the Office that a change was being submitted.

From a technical aspect, the provisions of 37 C.F.R. §1.181 require that the regulation be invoked within two (2) months of the event complained of (i.e., the abandonment), Petitioner waited ten (10) months after abandonment and three (3) months after Notice thereof to seek relief under the regulation.

Further, Petitioner is reminded that to take advantage of the provisions of 37 C.F.R. §1.8 and §1.10 certificates of mailing must appear on the papers submitted or on the transmittal letter/form therefor itemizing those papers.

Out of an abundance of caution, Petitioners always are reminded that:

- the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and

- those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.⁷

⁷ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —
(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁸

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁹

Delays in responding properly raise the question whether delays are unavoidable.¹⁰ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).¹¹

And the Petitioner must be diligent in attending to the matter.¹² Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹³))

⁸ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁹ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

¹⁰ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

¹¹ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹² See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

¹³ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹⁴

Further, the commentary at MPEP §711.03(c) provides:

* * *

**B. Petition To Withdraw Holding of Abandonment Based on Evidence That
a Reply Was Timely Mailed or Filed**

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal

¹⁴ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.

* * *

And the regulation (37 C.F.R. §1.181¹⁵) requires that relief be sought within two (2) months of the act complained of.

¹⁵ The regulations at 37 C.F.R. §1.181 provide:
§ 1.181 Petition to the Director.

◇

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

Thus, as of this writing Petitioner appears not to have satisfied and not to be able to satisfy the “showing” or “timeliness” requirements described above.

As to the Allegations
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate--a terminal disclaimer and fee.

As of this writing Petitioner has not satisfied the “reply” and “showing/statement” requirement of the regulation.

As to the Allegations
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate--a terminal disclaimer and fee.

As of this writing Petitioner has not satisfied the “reply” and “showing/statement” requirement of the regulation.

CONCLUSION

Because it appears that Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**; and the petition as considered under 37 C.F.R. §1.137(a) is **dismissed**; and the petition as considered under 37 C.F.R. §1.137(b) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:¹⁶

¹⁶ On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information. see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

By mail: Commissioner for Patents¹⁷
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

¹⁷ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,590	04/21/2004	Yi-Qun Li	034172-017	6712
7590 07/06/2005				
Intematix Corporation 351 Rheem Blvd. Moraga, CA 94556				
EXAMINER KOSLOW, CAROL M				
ART UNIT		PAPER NUMBER		
1755				
DATE MAILED: 07/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,590

Applicant(s)

LI ET AL

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/21/04, 11/9/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

This application is claiming the benefit of a provisional application under 35 U.S.C. 119(e). However, this application was not filed within twelve months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application.

Note: If the day that is 12 months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application claiming the benefit of the provisional application may be filed on that next succeeding business day.

The drawings are objected to because the individual graphs should be labeled in figures 1 and 8. It is noted that the specification teaches figure 1 has parts a-d. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

Art Unit: 1755

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The disclosure is objected to because of the following informalities: In paragraph [0005], "(????)" needs either to be deleted or explained. The conjunctions between the elements defining A, B and M is missing. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The process of claims 11 and 18 are not found in the specification. Claims 4-9 teach the coercive field is "about" a value and table 1 and paragraphs 25 and 26 teach the coercive field is an exact value. The specification fails to provide antecedent basis for "about". The claimed saturation magnetizations of claims 4-9 are not taught in the specification. The specification teaches residual magnetization. Finally, the specification does not teach the claimed elements of Y, Gd, Ta, W, Nb, Al, Bi, Cr and V.

Claims 1-18 are objected to because of the following informalities: The formulas of claims 1, 4-9, 12, 15, and 16 should be rewritten using subscripts. In claims 1, 2, 10-13, 17 and 18, there is no conjunctions in the claimed lists of elements. In claims 3 and 14, "material" should not be capitalized. In the last line of claims 1 and 12, "and" should not be capitalized. In claims 10 and 17, "s single phase" should be "a single phase" and "sigle" should be "single". In claims 10, 11, 17 and 18, "of" is missing after the phrase "metal oxides". Finally, it is suggested to rewrite step 1 of claims 10 and 17 so it is clear the process is selecting metal oxides in

Art Unit: 1755

amounts to provide the desired stoichiometry of the final perovskite oxide. Appropriate correction is required.

Claims 10, 11, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for producing ferromagnetic perovskite oxides having the formulas $(A_{1-x}M_x)BO_3$ and $A(B_{1-x}M_x)O_3$, where $0 < x < 0.15$ does not reasonably provide enablement for any ferromagnetic perovskite oxide containing the listed metals. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite processes for making ferromagnetic perovskite oxides. This encompasses any ferromagnetic perovskite containing the metals, such as $Pb(Fe_{2/3}Nb_{1/3})_xTi_yZr_zO_3$, where $x+y+z=1$. However, the specification only teaches the producing oxides having the formulas $(A_{1-x}M_x)BO_3$ and $A(B_{1-x}M_x)O_3$, where $0 < x < 0.15$. Such a limited disclosure does not support the breadth of the instant claims. The examiner suggests the incorporation of these formulas into the respective claims.

Claims 3-11 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 17 are duplicate claims. Claims 11 and 18 are duplicate claims. Claims 3, 14 and 15 are improperly depend on claims 1 and 12 respectively. The x range in claims 3 and 14 are broader in scope since they include the end points of 0 and 0.15. If they exclude the end points, then these claims do not further limit claims 1 and 12 respectively, since they are identical to the x value range in the independent claims. The formula in claim 15 is outside that

Art Unit: 1755

of claim 12 since claim 12 teaches the maximum amount of Fe is less than 0.15 and claim 15 teaches the amount of Fe is 0.75. Claims 4-9 recite the limitations "said saturation magnetization" and "the coercive fields". There is insufficient antecedent basis for these limitations in the claims or in claim 1. Claims 15 and 16 recite the limitations "said magnetic Curie temperature" and "the coercive fields". There is insufficient antecedent basis for these limitations in the claims or in claim 12. Claims 11 and 18 are indefinite since the composition of the target is unclear. It is unclear if the target is a mixture of the claimed oxides which will form the perovskite or if it is composed of the perovskite.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,641,940. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed formula in the patent overlaps that claimed in this application.

Art Unit: 1755

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chemical

Abstract citation 134:140214 for the article by P'rvanova et al.

This abstract teaches perovskite oxide materials having the formula (1-x)

$\text{BaTiO}_3 \cdot x\text{NiTiO}_3$, where x is 0.05, 0.1, 0.15. This formula can be rewritten as $\text{Ba}_{1-x}\text{Ni}_x\text{TiO}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

Claim 1 is rejected under 35 U.S.C. 102(a or b) as being clearly anticipated by Chemical

Abstract citation 140:311312 for the article by Srivastava et al.

This reference is applicable either under 35 USC 102(a) or (b) depending on the publication month which the Examiner was unable to determine.

This abstract teaches perovskite oxide materials having the formulas $\text{Sr}_{0.9}\text{Fe}_{0.1}\text{TiO}_3$ and $\text{Pb}_{0.9}\text{Fe}_{0.1}\text{TiO}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

Art Unit: 1755

Claim 12 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chemical Abstracts citation 132:312137 for the article by Langhammer et al.

This reference teaches perovskite oxide having the formula $\text{BaTi}_{1-x}\text{Mn}_x\text{O}_3$, where $0 < x \leq 0.05$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

Claims 12-14 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 4-56080.

The abstracts and formulas in the reference teach perovskite oxides having the formula $\text{ATi}_{1-x}\text{M}_x\text{O}_3$, where A is $\text{Ca}_{1-y}\text{Sr}_y$, y is 0-1 and when M is Fe or Co, x is $0 < x \leq 0.05$ and when M is Cr, Mn or Ni, x is $0 < x \leq 0.03$. Page 442 exemplifies $\text{SrTi}_{0.95}\text{Fe}_{0.05}\text{O}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic and that $\text{SrTi}_{0.95}\text{Fe}_{0.05}\text{O}_3$ would inherently have the claimed properties, absent any showing to the contrary.

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,641,940.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Art Unit: 1755

This patent exemplifies perovskite oxides having the formulas $\text{Ba}_{0.6}\text{Sr}_{0.4}\text{Ti}_{0.9}\text{V}_{0.1}\text{O}_3$ and $\text{Ba}_{0.6}\text{Sr}_{0.4}\text{Ti}_{0.92}\text{Ta}_{0.07}\text{Cr}_{0.01}\text{O}_3$. The reference clearly teaches the claimed material. Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic, absent any showing to the contrary.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,641,940.

There is evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as U.S. patent 6,641,940 at the time this invention was made, or was subject to a joint research agreement at the time this invention was made.

However, this patent additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

This reference teaches perovskite oxides having the formulas $\text{MTi}_{1-x}\text{V}_x\text{O}_3$, where M is Ba and/or Sr and x is 0.02-0.3. This composition overlaps that claimed. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974);

Art Unit: 1755

In re Fields 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed composition. The reference overlaps the claimed material.

Therefore one of ordinary skill in the art would expect it to be inherently ferromagnetic in the overlapping range, absent any showing to the contrary.

Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/40058.

U.S. patent application publication 2005/0006249 is the English equivalent for WO 03/40058.

This reference teaches producing a perovskite oxide having the formula $(\text{Ln,A})(\text{Ti,Fe})\text{O}_3$ where Ln can be La and A is at least one of Ca, Sr and Ba by mixing oxides of Fe, Ti, A and Ln in the desired stoichiometry and firing the mixture at a time and temperature sufficient to form a single phase of the oxide, where the firing atmosphere can be an inactive gas atmosphere (para [0088] and examples). It is notoriously well known that argon gas is an inactive gas that is used as an inactive gas atmosphere. Therefore one of ordinary skill in the art would have found it obvious to use argon as the taught inactive gas atmosphere. The reference suggests the claimed process.

Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,434,742.

This reference teaches forming ferroelectric perovskite oxide thin films by forming a target of the ferroelectric oxide and then depositing a thin film of the ferroelectric oxide by sputtering in an argon atmosphere at 600°C (examples). This reads upon the claimed process.

Art Unit: 1755

The taught ferroelectric perovskite oxide can contain lead, tungsten and iron or cobalt or lead niobium and manganese, iron or nickel (claim 9). The reference suggests the claimed process.

Claims 4-9 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

There is no teaching or suggestion in the cited art of record of materials having the claimed formulas.

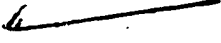
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 1, 2005


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Tech. Center 1700